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To: Commissoner for Patents **From:** Steven L. Nichols

Fax: (571) 273-8300 **Pages:** **10** including coversheet

Phone: **Date:** December 19, 2006

Re: Application No. **10/635,362**

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40169-0031 Serial No.: 09/821,648

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application: Rob Falke	**Examiner:** WILKENS, Janet Marie
Application No.: 10/635,362	**Group Art Unit:** 3637
Filed: August 5, 2003	**Confirmation No.:** 8884
Title: "Method and Apparatus for Storing and Preserving Writings and Memoranda"	

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Sir:

Transmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on **October 19, 2006**.

This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new ground rejection.)

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Signature: _____
Rebecca R. Schow

Respectfully submitted,

By: _____
Steven L. Nichols (Reg. No.: 40,326)
Attorney/Agent for Applicant(s)
Telephone No.: (801) 572-8066
Date: December 19, 2006

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DUPLICATE

Serial No.: 09/821,648

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Date: December 19, 2006

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Application No.: 10/635,362 Attorney Docket No.: 40055-0001

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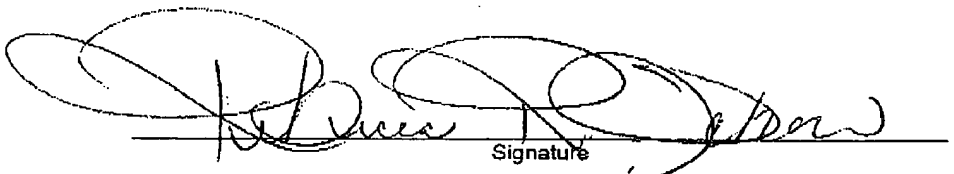

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Patent Application of:

Rob Falke

Application No. 10/635,362

Filed: August 5, 2003

For: Method and Apparatus for Storing and Preserving Writings and Memoranda

Group Art Unit: 3637

Examiner: WILKENS, Janet Marie

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a Reply Brief under Rule 41.41 (37 C.F.R) in response to the Examiner's Answer of October 19, 2006 (the "Examiner's Answer" or the "Answer"). In Section 10, the Answer contains various response to the arguments made in Appellant's brief. Appellant now responds to those arguments as follows.

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Claim 12 (35 U.S.C. § 112, Second Paragraph):

The Office Action rejected claim 12 under 35 U.S.C. § 112, second paragraph, because, according to the Action, "it is unclear how carving, wood burning, etching, brush marks, imprints and stamps can be considered handwritten writings." (Action of 2/24/06, p. 3). Appellant pointed out that, in carving, wood burning, etching, etc., a human can use an instrument, such as a knife, wood burner, etc., to produce handwriting. This writing is handwritten in the same sense as if the writer were holding a pen or pencil.

In response, the Answer argues that "the only handwritten writings disclosed are the handwritten letters (using pens or pencils)." (Answer of 10/19/06, p. 7). This is clearly incorrect. Appellant's specification expressly states that: "'writings' may include, but are not limited to, *handwritten* letters, words, phrases, names, initials, signatures, drawings, sketches, paintings, or any other form of markings. Writings may be made, for example, with any one or more of the following: pencil, pen, marker, paintbrush, woodburning tool, carving tool, etching tool, etc." (Appellant's specification, paragraph 0017).

The Answer further states that "applicant argues that the above features make handwritten writings because instruments which are operated by hand are employed. However, this is not always the case." (Answer of 10/19/06, p. 7). This is correct, but entirely irrelevant. Appellant's claims, e.g., claims 1 and 12, recite "handwritten writings." Therefore, any example posited by the Examiner, in which a writing instrument is not operated by hand, is outside the terms of Appellant's claims and of no relevance to this appeal.

Appellant has consistently pointed out that the claims at issue are directed to a novel method for storing *handwritten* writings. This is so that, after acquiring an heirloom, the owner

or others can enhance its value with *personally, handwritten* writings. (Appellant's specification, paragraph 0017). Thus, the cited prior art, such as Greiwe, that teaches writings that are not handwritten, do not apply to Appellant's claims, and Appellant's has correctly and consistently stated so.

Consequently, claim 12 is thought to be clear and consistent with the other claims. Thus, the rejection of claim 12 under § 112, second paragraph, should not be sustained.

Claim 1:

Claim 1 recites: "A method for storing handwritten writings, said method comprising storing said handwritten writings on a piece of furniture, wherein said furniture comprises a member comprising a surface of a material used to construct said furniture that is configured *to permanently receive said handwritten writings.*" (emphasis added). Appellant has noted in Brief that the cited prior art merely teaches sheets of paper, on which handwriting may appear, temporarily attached to a piece of furniture.

Contrary to the clear meaning of claim 1, the Answer takes the position that a sheet of paper clipped to a shelf or drawer, as in McClintock or, placed under glass in a desk, as in Hardin, can be interpreted as meeting claim 1. Specifically, "If the papers are never removed, they can be considered permanent." (Answer of 10/19/06, p. 8). This is quite a speculation made in order to wrest all meaning from the word "permanently." Thus, in making this argument, the Answer must go beyond any reasonably interpretation of claim 1.

One of skill in the art looking at McClintock or Hardin, in which a sheet of paper is releasably attached to a shelf or drawer, would clearly *not* understand any writing on that paper to

have been "*permanently* received" by the furniture. (Emphasis added). To the contrary, Hardin expressly describes how the paper can be readily accessed, changed or replaced. (Hardin, page 2, left col., lines 31-41).

While the Examiner is to give the claim language its broadest *reasonable* interpretation, it is clearly *unreasonable* to consider that the claimed method, including furniture comprising a member with a surface "configured *to permanently receive said handwritten writings,*" can be read on the cited prior art, including McClintock or Hardin which teach ***temporary*** means for attached sheets of paper to drawer or shelf.

The Examiner has adopted an *unreasonable* interpretation of the claim language in order to support the rejection of claim 1. For at least these reasons, the rejection of claim 1 should not be sustained.

Claim 28:

Claim 28 recites: "The method of claim 1, further comprising specifically designating said member as being intended to receive said handwritten writings in materials presented with said furniture when said furniture is offered for sale and has not yet received said handwritten writings." With regard, claim 28 recites "please not[e] that this claim is a method claim and not a business method claim." (Answer of 10/19/06, p. 10). It is unclear why the Examiner would take this position. By referencing a "sale" in claim 28, Appellant clearly intends claim 28 to be a business method claim.

Nothing in the prior art teaches or suggests this business method in which materials are presented with a piece of furniture for sale, where those materials specifically designate a

member of that furniture as being intended to permanently receive *handwritten* writings. For at least these reasons, the rejection of claim 28 should not be sustained.

Claim 30:

Claim 30 recites: "The method of claim 2, wherein said markings comprise a genealogical form." Appellant had requested, prior to filing this appeal, that the Office cite prior art actually teaching a genealogical form on a surface of a material used to construct a piece of furniture (claim 30).

Appellant's request was ignored and continues to be ignored. Specifically, the recent Answer still fails to address claim 30. Thus, no *prima facie* case of unpatentability has been made with respect to claim 30.

40055-0001 **10/635,362**

In view of the foregoing, it is submitted that the final rejection of the pending claims is improper and should not be sustained. Therefore, a reversal of the Final Rejection of February 24, 2006 is respectfully requested.

Respectfully submitted,

DATE: December 19, 2006

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Rebecca R. Schow